

**REMARKS**

Claims 1-9, 12, 13 and 15 are pending in this application. By this Amendment, claims 1, 12, 13 and 15 are amended. The amendments introduce no new matter. Claims 10, 11 and 14 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Claim 11 is canceled as drawn to a non-elected species. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

**I. Response to Requirement For Information Under 37 C.F.R. §1.105**

The Office Action, in paragraphs 2-10, renews a Requirement for Information Under 37 C.F.R. §1.105. Specifically, Applicants are reminded of a requirement to provide the citation and a copy of each publication which any of the Applicants authored or co-authored, and publications describing inventions the Assignee owns or that Assignee has knowledge of, which describe the claimed subject matter, specifically of a "staple having a storage medium."

In reply to the Requirement for Information, Applicants searched available databases, including Assignee's earlier U.S. patent applications, for prior art documents describing the claimed subject matter of a staple having a storage medium. Applicants found, however, no such document.

Additionally, an Assignee representative, who is in a position to know the relevant information, was queried regarding whether (a) Assignee has any co-pending related U.S. patent applications, (b) whether the inventors have published any related articles or made any related presentations regarding the subject matter and/or (c) whether the Assignee is aware of any such information. The response to this inquiry was previously that Assignee's representative could find no related documents or disclosures.

The Office Action, in paragraph 2 states, "In view of the newly discovered article entitled 'Bridging Physical and Virtual Worlds With Electronic Tags' (hereinafter "Want I")

written by authors associated with Xerox, that discusses a staple having a storage medium, the Examiner restates the Requirement for Information from the last Office Action." The Office Action, in paragraph 10 states (in bold and partially italicized, these formats not being repeated here), "At this time, the Examiner does not wish to engage in a discussion of semantics relating to the Assignee's compliance with this Requirement for Information. The Assignee is required to provide the citation and a copy of each publication the Assignee owns or that the Assignee has knowledge and which describes the claimed invention of the staple having a storage medium." Further, in paragraph 9, the Office Action reminds the Applicants of Applicants' requirement to respond with candor and good faith under 37 C.F.R. §1.56.

The combination of all of the above statements seems to imply that the Applicants and/or the Assignee have failed in their Response under the standard of candor and good faith required by the Rules. In this regard, the Examiner mistakenly misunderstands the corporate relationship between Assignee for this application, Fuji Xerox Corporation, and Xerox Corporation. The Examiner appears to want to attribute an awareness of research undertaken by individuals at Xerox PARC (Palo Alto Research Center) to the Assignee. At the time this application was filed in Japan, August 28, 2002, Xerox Corporation owned only a 25% equity in Fuji Xerox. Fuji Photo Film Corporation Limited owned the remaining 75% equity. In other words, Fuji Xerox Corporation was not, and has not been, a Japanese subsidiary of Xerox Corporation at least on or after August 28, 2002.

The above notwithstanding, it is improper to conclude that the cited reference , Want I, can in any way be construed as evidence showing Applicants' and/or Assignee's Response to the Requirement for Information was previously improper and/or insufficient. Applicants, and the Assignee, understand the requirement for disclosure, and the requirements for candor and good faith. In this regard, the Assignee has diligently undertaken a search in reply to the Requirement for Information. Further, in reply to the renewed

requirement, Applicants and the Assignee more broadly interpreted the recited claim feature than they had before and conducted an updated search of all relevant databases. The result of this search is that neither Applicants nor the Assignee have ascertained any relevant prior art, printed materials or U.S. patent applications owned by, or known to, Fuji Xerox.

Applicants believe that they have fully complied with the requirements of 37 C.F.R. §§1.105 and 1.56, and that the above factual statements are a complete reply as indicated in paragraph 9 of the Office Action.

## **II. The Claims Recite Allowable Subject Matter**

The Office Action, in paragraph 12, rejects claims 1-10 and 12-15 under 35 U.S.C. §102(b) as being anticipated by Want I. The Office Action, in paragraph 13, rejects claims 1-3, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,551,681 to Ferrara. The Office Action, in paragraph 15, rejects claims 4-8 under 35 U.S.C. §103(a) as being unpatentable over Ferrara in view of U.S. Patent No. 6,008,727 to Want et al. (hereinafter "Want II"). These rejections are respectfully traversed.

Want I teaches a variety of scenarios implemented using a novel combination of inexpensive, unobtrusive and easy to use RFID tags, tag readers, portable computers and wireless networking (page 370). Specifically, when referring to certain sample applications and prototypes, Want I indicates that tags can be located upon or within a document binder as shown in Fig. 3, can be embedded within other marks such as an embossing seal as shown in Fig. 4 or can even be located in or on the document staple (page 373).

Ferrara discloses stapling a document with a staple needle in a postprocessing as part of a disk compiler integrated into a disk stacker or disk-in-disk finisher in which a job set is compiled and a stapling system may be provided for stapling the compiled sets (Abstract). The Office Action indicates that Ferrara can reasonably be considered to anticipate the subject matter of the pending claims essentially because it includes a stapler. The stapling system of

Ferrara is for stapling compiled sets as indicated in the Abstract, and throughout the disclosure.

Want II discloses an example of reading data from an electronic tag 150 having an optionally connected sensor 160 (see Fig. 2 and col. 10, line 59 - col. 11, line 3).

Claim 1 recites, among other features, an attachment unit for attaching a storage medium to the image forming member on which it has started to form the image, wherein the attachment unit staples a staple needle to a single image forming member. Claim 15 recites, among other features, attaching a storage medium to the image forming member on which it has started to form the image, wherein attaching comprises stapling a staple needle to a single image forming member. None of the applied prior art references explicitly or inherently discloses such a function. Staple needles are generally used to bind two or more image forming members and each of the references, particularly Ferrara, recognizes such a use. Accordingly, one of ordinary skill in the art would not have been motivated to attach a staple needle holding a storage medium to a single image forming member. In this regard, simply because one of ordinary skill in the art could have, or may have tried, to do so does not establish that one of ordinary skill in the art would have recognized that any of the applied prior art references alone or in combination could reasonably be considered to teach, or to have suggested, the combinations of features varying recited in independent claims 1 and 15.

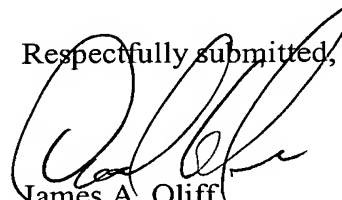
With regard to independent claims 12 and 13, simply because any of the references may disclose attaching an RFID tag to, or embedding an RFID tag in, a staple needle that is then attached to an image forming medium, neither teaches, nor can they reasonably be considered to have suggested, employing the staple needle recited in the claims as an antenna for transmitting and/or receiving stored data as is recited, among other features, in at least independent claims 12 and 13.

For at least the reasons discussed above, none of Want I or Ferrara, can reasonably be considered to teach, or to have suggested, the subject matter of the pending claims, even when taken in combination, where appropriate, with Want II. Further, claims 2-9 and 15 are also neither taught, nor would they have been suggested, by any combination of the applied prior art references for at least the respective dependence of these claims directly or indirectly on independent claim 1, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9, 12, 13 and 15 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT/cfr

Attachment:  
Petition for Extension of Time

Date: February 24, 2006

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